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Attorney Docket 183-U.S.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Algirdas A. Underys)	
)	
Serial No.:	08/991,113)	On appeal from:
)	
Filing Date:	December 16, 1997)	Group 1742
)	
Title:	Heat Treatment Method and)	
	Apparatus)	

The Honorable Commissioner
of Patents and Trademarks
Washington, DC 20231

ON APPEAL
Appeal No. 2001-0359
(Formerly Appeal No. 10,359)

**LETTER TRANSMITTING
REQUEST FOR
EN BANC REHEARING**

We transmit, attached hereto, a Request for En Banc Rehearing with attachments, in triplicate, in the above entitled appeal.

In the event the Board wishes to receive additional copies of the enclosed Request,

we will be pleased to forward as many as requested by one day courier.

Respectfully submitted,

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Reg. 19013

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Attorney Docket 183-U.S.

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(Formerly Appeal No. 10,359)

**REQUEST FOR
EN BANC REHEARING**

An en banc rehearing of the decision rendered May 27, 2004, by a three person panel of the Board of Patent Appeals and Interferences in the above appeal is requested.

This request is made to resolve the legal conflict between (i) 35 U.S.C. 41, (ii) Rule 137 and (iii) MPEP, 8th Ed., pp. 200-100, 101 on the one hand, and dicta in In re Berg, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed Cir. 1998) on the other hand, in a one way/two way double patenting context.

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AND INTERFERENCES

Applicant is not currently aware of any disputed fact issues.

**Statement of
Reasons for Request**

The decision of May 27, 2004 misapprehends three points of law, a reversal of any one of which would result in a reversal of the decision.

I. Firstly: The panel erroneously ruled that a 2-1/2 month hiatus in pendency which was cured by a timely Rule 137(b) petition which complied with all statutory requirements, and the payment of the requisite Rule 137(b) fee, did not restore the application to a condition as though no abandonment occurred.

The panel should have ruled in recognition of 35 U.S.C. 41, Rule 137, and MPEP, 8th Ed., pp 200-100,101 that the 2-1/2 month cured hiatus had no impact on the question of applicant delay in a one way/two way double patenting context..

II. Secondly: Even should an en banc panel rule that a pendency hiatus cured by a 137(b) petition is relevant to the issue of delay by applicant in the context of the one-way/two way test for double patenting, the panel erred in ruling that a single instance of replying to Office Action response deadlines more than one month after a scheduled deadline was a delay which nullified the general rule that a specific application which is filed after the filing of a broad application, but issues first, may not be used to reject the first filed broad application.

III. Thirdly: Even though an en banc panel should rule that (1) a Rule 137(b) petition and fee does not cure a 2-1/2 month pendency hiatus, and (2) that said single instance of replying to a scheduled Office Action response deadline more than one month after the deadline is relevant to the question of delay, by applicant, in a one way/two way double patenting context, the panel erred in not applying an equitable analysis, including delays by the Patent Office (such as 5-1/2 months to remand an application from the BPAI to the Examiner to consider an agreed allowance enabling amendment) in resolving the question of delay in the context of the one way/two way test for double patenting.

Supporting Statement

With Respect to I:

Attention is directed to section "B. There Was No Delay By Applicant in the Context of the May 27, 1999 Office Action which Justifies Use of the One-Way Test" on pp. 3-6 of applicant's Request for Rehearing.

35 U.S.C. 41 is the statutory basis of Rule 137, and a reading of the legislative history of the most recent amendments to 35 U.S.C. 41 discloses that said amendments were made in an effort to liberalize the effect of prior law, specifically by giving the Commissioner more discretion to deal with procedural matters. Specifically:

"This section would permit the Commissioner to have more discretion than present law ..." House Report No. 97-542, 97th Congress 2d Session, May 17, 1982.

With Respect to II:

No example of a single instance in responding to an Office Action outside a scheduled response period being held to be delay attributable to applicant in a one way/two way double patenting context has been found after a search.

With Respect to III:

While we concur in the general concept that the Patent Office has an obligation to administer the Patent Law even handedly, we submit that the Patent Office must recognize, as a higher obligation, the duty to deal fairly with the public, and the position of the panel that the Patent Office bears absolutely no responsibility for the progress of an application through the Office, and that the only consideration in a one way/two way double patenting context is applicant's actions, is manifestly unfair, particularly when, as here, drastic legal consequences flow from bungled ministerial actions in the Office.

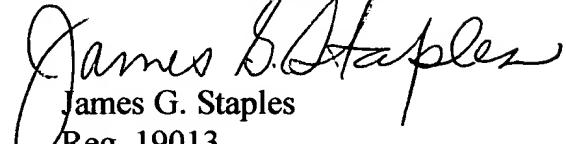
Attention is directed to "Point 2: Any Delay in the Pendency of this Application Which Resulted in a Lack of Synchronization With Application 09/160,895 Which Matured Into the '885 Patent is Attributable Solely to the Patent Office" on pp. 6-11 of applicant's "Request for Rehearing".

The panel's May 24, 2004, "Decision" and applicant's "Request for Rehearing" are attached hereto for ready reference. The Decision contains legal reasoning and facts which were not available to applicant until receipt of the Decision. It is believed that these two

documents are the most relevant to the issues requested to be reheard.

Respectfully submitted,

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On appeal from:
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ON APPEAL
Appeal No. 2001-0359
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REQUEST FOR REHEARING

Point 1: The Board's (A) Reliance on In re Berg and (B) Application of the One-Way/Two-Way Double Patenting Test in the Context of the May 27, 1999, Office Action Misapprehends the Law.

The Board's reasoning following its statement:

"As a preliminary matter, this panel must decide whether the examiner was correct in applying the one-way test." Decision, p.4

misapprehends the law in two respects.

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BOARD OF PATENT APPEALS
AND INTERFERENCES

A. **Berg Does Not Justify Use of the One-way Test in a "Broad Filed First and Specific Filed Later But Issues First" Context**

After acknowledging that In re Stanley, 214 F.2d 151, 102 USPQ 234 (CCPA 1a54), In re Borah, 354 F.2d 1009, 148 USPQ 213 (CCPA 1966) and In re Braat, 937 F.2d 589, 19 USPQ 7d 1289 (Fed. Cir. 1991), correctly state the law that a two-way determination of obviousness is proper when the broad claim application is filed first and the specific claim application is filed later but issues first, Decision, p.5, the Board cites In re Berg, 140 F.3d 1428, 1432, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998) as support for denying the two-way test in an early-filed-broad-application/later-filed-specific-application context. Berg, however, does not stand for ignoring the two-way test in this fact situation because in Berg the broad application was not filed first, as here, and hence reliance on Berg to negate a two-way test in this case is not justified. Rather, the general rule for this fact situation set out in Stanley, Borah, and Braat, control this case.

Specifically, in Berg (a) the board and specific claim applications were filed simultaneously, and (b) the conduct of the applicants was questionable, bordering on gamesmanship, none of which is present here. As to (b), (i) Berg clearly could have put all claims in a single application, Berg at 1228, (ii) the claims in the two applications were "almost identical", Berg at 1228, (iii) the specifications "are identical", Berg at 1231, (iv) the PTO was not informed of the dual approach, Berg at 1236 and (v) Berg did not dispute obviousness, Berg at 1228. None of these or similar factors are present here.

Further, on pages 1230 and 1231 the Berg court listed the factors which were missing

in the Berg appeal but were present in Braat which formed the basis on which the Braat court applied a two-way test. All of these Braat factors are present in this case; i.e.: this case is on all fours with Braat and its companions In re: Calvert 97 F.2d 638, 640; 38 USPQ 184,185 (CCPA 1938), Stanley, and Borah and it was not proper to use the dicta in Berg as a basis for denying applicant the benefit of the two-way test.

Now, although the Berg Court listed egregious factors, not present here, as the basis for justifying the one-way test, its actual holding was much narrower; specifically it was:

"...we base our affirmance on the second stated rationale of the Board because Berg could have filed the claims of its separate application in a single application, and it simply chose to file two applications despite nearly-identical disclosures. Berg is not entitled to the two-way test."¹

In summary, no authority has been cited for denying applicant the benefit of the two-way test.

B. There Was No Delay By Applicant in the Context of the May 27, 1999 Office Action which Justifies Use of the One-Way Test

Applicant eliminated any attribution of delay to himself for the 2-1/2 month pendency hiatus following the May 27, 1999, Office Action by the filing of a Rule 137(b) petition and

¹For example, a cursory comparison of the '885 patent disclosure and the instant disclosure discloses that the claims of each application could not have been filed in either application as the Board has conceded, to this point, in its Decision, p.7.

the payment of the 137(b) fee. The petition and its accompanying fee bridged the 2-1/2 month hiatus; any other result is not reasonable. Specifically:

An application is either in good standing or it is not in good standing. If it is in good standing it has to be in good standing for all purposes; not for all purposes except a first possibility or a second possibility or a third or fourth or sixth or more. This proposition accords with the fair and efficient administration of proceedings in the Patent Office. For example, in the legally indistinguishable situation of the delayed payment of the final fee cured by a 137(b) petition, the MPEP, 8th Ed., pp.200-100, 101 states:

"The issue fee may, however, be accepted by the Commissioner if on petition it is shown that the delay in payment was unavoidable and payment of the fee for delayed payment of the issue fee under 37 CFR 1:17(1), in which case the patent will issue as though no abandonment had occurred (MPEP § 711.03(c)), (37 CFR 1.137(a)). The issue fee may also be accepted if on petition it is shown that the delay in payment was unintentional and upon payment of the fee for delayed payment of the issue fee under 37 CFR 1.17(m) (37 CFR 1.137(b))."

(underlining ours)

Indeed, if the Board's position that an accepted 137(b) petition does not cure any flaws premised on time of pendency, then the anomalous result is that applicant's 2-1/2 month hiatus disqualifies applicant from the benefit of the two-way test, whereas if applicant

had taken advantage of each of the three month extensions for each of the five Office Actions for a total of an additional fourteen months² of pendency, he would not have been so disqualified.³ Thus, had the applicant obtained five months of extensions (assuming no 2-1/2 month hiatus) would the Board have held that applicant could not invoke the two-way test? or ten months? or the additional 14 months available under the Rules? Where would the Patent Office draw the line?

In essence, following filing of the 137(b) petition and fee and the unquestioned return to pending status the question becomes, did applicant own an application which was regular on its face but had a hidden flaw in its core which could wreck it, or did applicant own an application which was regular on its face and had a solid core. Since we are not aware of any authority which holds that bridging a short gap in prosecution by following an authorized procedure in the Statute and Rules and paying a fee much greater than a filing fee is insufficient to deny applicant the benefit of the two-way test, and the Board has cited none, we respectfully submit there is no legal basis for the Board's denial of the two-way test.

The reasonable and efficient administration of the Patent Law by the Patent Office dictates that if an application pends, it pends for all purposes, and whether it pends for 2-1/2 months longer than it might have due to a 137(b) petition following prompt responses to

²The applicant requested one one-month extension.

³We call the Board's attention to the fact that a fair reading of the record discloses that applicant made a strenuous and good faith effort to close out prosecution at the Examiner's desk including initiating telephone contact with the Examiner to resolve differences of opinion.

numerous Office Actions, or for 14 months longer as a matter of right in the absence of a cured hiatus, no differentiation can be made in the context of the efficient administration of the Patent Law.

Point 2: Any Delay in the Pendency of this Application Which Resulted in a Lack of Synchronization With Application 09/160,895 Which Matured Into the '885 Patent Is Attributable Solely to the Patent Office

A. Filing the Issue-Enabling March 4 Amendment Was a Commendable Attempt by Applicant to Shorten Pendency, Not Delay Pendency

On page 8 of the Decision the Board stated:

"Second, appellant filed an amendment (Paper No. 23) obviating the sole grounds of rejection in the previous appeal more than one and one-half (1-1/2) years after the examiner's answer was mailed and three (3) months after a Notice of Allowability was mailed in the application which matured into the '885 patent. As explained by the examiner (Answer, p. 6):

[T]he Amendment filed by Appellant in March 2002 (Paper no. 23) successfully removed all grounds of rejection pending at that time, leaving only obviousness-type double patenting rejections to be made.^[9] Had this amendment been filed at any time prior to a Notice of Allowability in the September 1998 application which matured into the '885 patent, no grounds of rejection would have been remaining and the present claims would have issued. The Notice of Allowability in

the '885 patent was issued in December 2001. Thus, if Appellant had submitted the Amendment of March 2002 at any time during the nearly two-year period between December 1999 (when the original Notice of Appeal was filed in the present application) and December 2001 (when a Notice of Allowability was issued in the "later-filed" application), no double patenting issue would have been raised, and no rejections would have been pending with respect to the appealed claims. [Emphasis in original.]

The above double spaced text inferentially rises the accusatory question of applicant: why did you wait 1-1/2 years to file the issue enabling amendment of Paper No. 23? (which put the application in allowable condition)?

The answer is straightforward and reasonable and negates any attribution of delay to applicant.

By February 2002 this application had been pending over four years and thus not only was applicant not going to receive a 17 year patent, he might not even receive a 15 or a 14 year patent; the Board had not acted in over 1-2/3 years.

Something had to be done to stem the erosion of valuable patent rights. It was therefore up to applicant to take the initiative, and the record shows that he did.

Specifically, please refer to Attachment A which discloses:

On the morning of February 11, 2002, applicant's attorney "JGS" telephoned the Board of Appeals at (703) 308-9797, was transferred to the desk of Mr. Craig Fineberg, and left word for Mr. Fineberg to get back to the attorney re: "(i.e.: procedure for getting case back to Examiner)".

At 12:55 p.m. on February 11, 2002, Mr. Fineberg returned the call and advised the attorney that there were "12 ex parte ahead of the instant appeal" + unknown no. of interference" cases (or items - handwriting unclear).

Mr. Fineberg advised that there were:

"2 ways to get to Examiner:

1) File an official amendment and Board will remand to Examiner automatically.

2) Bd. will remand if Examiner requests for specific reasons."

- JGS suggestion: call Examiner - attempt to work out a deal etc." could work in your favor."

On February 15 applicant faxed the seven page "UNOFFICIAL PAPER FOR DISCUSSION ONLY Examiner Wyszermowski Art Unit 1747" to the Examiner at 11:15 a.m. and left a telephone voice mail with the Examiner at 11:20 to the effect the paper was not signed and the Examiner should call if any questions.

On February 20 the attorney followed up with a phone call and "lwcb"; i.e.: Left Word to Call Back.

On February 21 Examiner Wyszermowski called the attorney and said the paper was "ok"; i.e.: put the application in allowable condition. Further:

"JGS - will send amendment to PTO - put appeal no. on paper - will come to his desk 'in a few days'."

By March 4 the "Unofficial Paper" was put in formal amendment form and filed by fax, Paper No. 23, we believe. Thus:

AS OF MARCH 4, 2002, WHEN THE APPLICATION WAS ALLOWABLE, THERE WAS NO DOUBLE PATENTING ISSUE IN EITHER THE INSTANT APPLICATION OR THE '885 PATENT APPLICATION; THE APPLICANT REASONABLY BELIEVED THAT THE CLAIMS IN THE TWO PENDING APPLICATIONS WERE DIRECTED TO SEPARATE INVENTIONS IN THE BROAD FIELD OF METALLURGICAL HEAT TREATMENT AND APPLICANT HAD NO REASON TO SUSPECT A NEW REJECTION BASED ON DOUBLE PATENTING WOULD SUBSEQUENTLY APPEAR.⁴

Consequently applicant's filing of an amendment 1-1/2 years after the Examiner's Answer was filed can in no way be pointed to as establishing delay attributable to applicant in a two-way one-way double patenting context; applicant had no hint that a double patenting rejection was lurking in the wings; indeed, he would have been quite justified in taking no action in early 2002 and simply wait for the Board's decision on issues totally unrelated to double patenting; the fact that he took action should be viewed as a commendatory action directed to shortening pendency of the application; it is quite wrong -- and unfair -- to point to this time period as a basis for finding fault in applicant's conduct. If fault must be allocated it must be allocated to the Patent Office. The waiting on the part of an applicant of more than 20 months following an Examiner's Answer is a measure of the efficiency of the Patent Office, not the applicant.

⁴The capitalized statement is supported in the record whether or not the Board believes the preceding eight paragraphs and attachment A are properly before the Board.

B. Additional Administrative Delay by the Patent Office was the Cause of Any Lack of Synchronization With the '885 Patent Application, and this Applicant Should Not Suffer For It

The above single spaced text under A. above together with footnote 9 on page 8 of the Decision positively demonstrates attribution of the remainder of any "delay" to the Patent Office in a two-way, one-way double patenting context. Specifically:

The amendment which put the application in allowable condition was filed March 4, 2002. The penultimate sentence in footnote 9 of the Decision states:

"The amendment was placed in the official file of Application 08/991,113 on March 8, 2002, and entered by the examiner on August 1, 2002, when the application was returned to the Examiner's jurisdiction." (underlining added)

By waiting almost 5 months to send the application from the Board to the Examiner via the daily interoffice mail system, ample time was provided for the '885 patent to issue and thereby provide the Examiner with a new basis for rejecting applicant's claims -- obviousness type double patenting, a basis which had never been hinted at earlier. Applicant is not a mind reader, nor was he required to anticipate every possible basis for rejection the Examiner might decide to enter following remand. Applicant was put in an impossible position by the Patent Office late in the day by the double patenting rejection. Surely the Board will not contend that a lapse of almost five months in remanding an application from the Board to the

Examiner to consider an issue enabling amendment is a lapse of time which should be attributed to the applicant, together with whatever dire consequences might conceivably flow therefrom.

What could applicant have done if the Patent Office had efficiently moved the application file from the Board to the Examiner?

At least the following:

The Examiner, pursuant to policy, would have immediately entered the amendment, since he had already approved it, and passed the application to issue following which the issue fee would have been quickly paid due to the decrease in term of the patent. But suppose the Examiner had informed applicant of the need, in his opinion, of entering a new rejection of obviousness type double patenting? The applicant could have petitioned under 37 C.F.R. 1.314 to defer issuance of the '885 patent until the two patents could issue simultaneously.

But the delay of almost five months by the Patent Office to do the ministerial act of returning the application to the Examiner following placement of the issue-enabling March 4 amendment in the file on March 8 precluded all those possibilities. Not only was applicant precluded from heading off any possible rejections but he has had the delay by the Patent Office attributed to him in a fashion which denies him valuable patent rights. This result is not equitable.

CONCLUSION:

The Board's reliance on MPEP §804(II)(B)(1)(b)(8th ed., Rev. 1, Feb. 2003):

"Unless the record clearly shows administrative delay by the office...the examiner may use the one-way obviousness determination..." Dec. p. 7

misapplies the law governing this case. It was administrative delay by the Office, not applicant, which made possible application of the one-way test by the Examiner. The pendency at the Board of over 23 months (August 11, 2000 to July 18, 2002) -- which included the nearly 5 months which lapsed between entry of the issue-enabling amendment into the application file on March 8, 2002 and remand to the Examiner on August 1, 2002 -- is an administrative delay entirely attributable to the Office; the 2-1/2 month "delay"⁵ preceding the December 16, 1999 Rule 137(b) petition is dwarfed by the over 23 month delay by the Office.

The Board has ruled, in effect, that any delay by an applicant, no matter how short, excuses a delay of any length by the Office; here, a 2-1/2 month "delay" by applicant excuses more than a 23 month delay by the Office.

This strict interpretation conflicts with the approach required by the legislative history of Rule 137(b):

⁵Assumed for purpose of argument; not admitted.

"This section would permit the Commissioner to have more discretion than present law..." House Report No. 97-542, 97th Congress 2d Session, May 17, 1982

and Rule 173 decisional law:

"But I think that in the rare case, such as this, that comes up, that, because of the fair administration of the law by the Patent Office, it would permit these rare situations to be accommodated instead of relying on the strict letter of the statute." Delgar Inc. et al v. Schuyler, Comr. Pats., 172 U.S.P.Q. 513 at 519, 1971; "This reasoning is guided by statutory construction, by principles of fairness, by demonstrated Congressional intent, and by the policies underlying the Constitutionality -- authorized patent system."

New South Industries, Inc. et al. v Apache Grounding Corporation, et al, 666 F. Supp. 1067 (M.D. Tenn. 1987); "As equitable considerations are involved, the facts of the case merit recitation here." Future Technology, Ltd. v. Quigg, Comr., 684 F. Supp. 430 (E.D. Va. 1988).

RELIEF REQUESTED

Withdrawal of the May 27, 2004, DECISION ON APPEAL and reversal of the Final

Rejection or, in the alternative, withdrawal of the May 27, 2004 DECISION ON APPEAL and remand to the Examiner to consider the two-way test for obviousness-type double patenting.

Respectfully submitted,

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2/11/02

TRS (→ Dan) appears (708) 308-9777
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law - (i.e. procedure for getting
case back to TRS inc.)

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Craig Frieberg → TRS -
1/2 to settle cases ahead, +
unknown no of interveners
at time

2 ways to get back to TRS

1) file an official amendment
and Board will remand to TRS
automatically

2) Bd will remand if TRS
requests for specific reasons
→ TRS sug. call TRS attorney
Suzanne Deale to "call
not in your favor"

Mr. James G. Staples

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Evanston IL 60201-1738

2/20/02

Trs → ER in - w - 1wcb

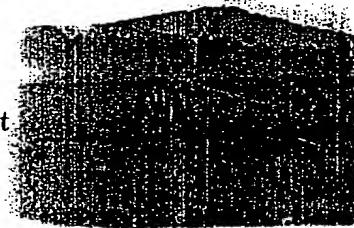
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- OR -

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will come to his desk
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